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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Michail Petropoulos et al.
Serial No.	:	09/819,180
Filed	:	3/27/2001
Art Unit	:	2161
Examiner	:	Nguyen, Cindy
Title	:	RECONFIGURABLE QUERY GENERATION SYSTEM FOR WEB BROWSERS
Atty. Docket No.	:	ENOS0001

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RESPONSE UNDER 37 CFR 1.111

This paper is being filed in response to the office action dated May 20, 2005.

STATUS OF REJECTION

Since the Examiner checked the FORM PTO-326 box entitled "This action is non-final," the subject office action is taken to be non-final. If this is incorrect, then the

Examiner is kindly asked to re-issue the office action with the appropriate markings.

Confusingly, the Examiner also checked the box "This action is FINAL." This is assumed to be in error because final rejection at this stage would be premature, pursuant to MPEP 706.07(d). "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement..." 37 CFR 706.07(a). In the present case, the Examiner has introduced a new ground of rejection that was not necessitated by Applicant's actions. Applicant has not made a single amendment to date. Accordingly, the present action would be premature if final.

If Examiner intentionally checked the "This action is FINAL" box, then the foregoing arguments constitute a request to promptly withdraw the final rejection as premature, pursuant to MPEP 706.07(d).

SUBMITTAL OF AFFIDAVIT UNDER 37 CFR 1.111

An affidavit under 37 CFR 1.111 is submitted herewith to establish invention of the subject matter of the rejected claims prior to the effective date of the Imamura reference, and thereby remove Imamura as a prior art reference.

"A rejection based on 35 U.S.C. 102(e) can be overcome by. . . [f]iling an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent or a U.S. patent application publication claiming the same patentable invention as defined in 37 CFR 1.601(n)." MPEP 706.02(b). "When a prior U.S. patent, U.S. patent application publication, or international application publication is not a

statutory bar, a 35 U.S.C. 102(e) rejection can be overcome by antedating the filing date. . . of the reference by submitting an affidavit or declaration under 37 CFR 1.131. . ." MPEP 2136.05.

The relevant date to overcome is Imamura's U.S. Application filing date, namely, March 15, 2001. "A person shall be entitled to a patent unless. . .the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent. . ." 35 USC 102(e).

Imamura's foreign application priority data is irrelevant. 35 USC 102(e) provides that "an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the International application designated the United States and was published under Article 21(2) of such treaty in the English language. . ." However, Imamura's priority application is not an "international application," rather it is a Japanese national application. "An international application as used in this chapter means an international application for patent filed under the Patent Cooperation Treaty prior to entering national processing at the Designated Office stage." 37 CFR 1.9(b). Furthermore, owing to its nature as a Japanese national patent application, Imamura's foreign priority application was not published in English.

Therefore, Imamura's relevant date is March 15, 2001, namely, its U.S. filing date.

The enclosed affidavit clearly establishes conception prior to March 15, 2001 coupled with diligence up to filing in the U.S. Patent & Trademark Office. In particular,

the inventors had already disclosed the invention to their attorney and the attorney had mailed a final draft of the subject patent application before March 15, 2001. ATTACHMENT A confirms that the attorney mailed the final draft of the patent application on March 13, 2001. This proves conception prior to March 15, 2001. "Conception was established at least as early as the date a draft of a patent application was finished by a patent attorney on behalf of the inventor." MPEP 2138.06

Work was conducted diligently from before March 15, 2001 up to filing of the patent application. Filing was conducted a mere ten business days from the date the application was sent to the inventors for signature. Of this time, several days were inevitably consumed by round trip document delivery, further time was required for serial review of the bound copy of 62 pages of text and 11 pages of drawings by three separate inventors, and additional time still was needed for the law firm to invoke outside photocopy services and prepare the appropriate USPTO transmittals and final papers. ATTACHMENT B shows work performed to prepare the application for filing and complete filing on March 22, 26, and 27 of 2001. ATTACHMENT B also shows that March 17-18 and 24-25 were not business/working days. ATTACHMENT C shows that March 23, 2001 was not an assigned workday for the law firm's sole secretary, a part-time contractor. In view of the foregoing, the inventors and their attorney exhibited diligence in constructively reducing the application to practice from a time prior to March 15, 2001.

The diligence of 35 U.S.C. 102(g) relates to reasonable "attorney-diligence" and "engineering-diligence", which does not require that "an inventor or his attorney drop all other work and concentrate on the particular invention involved. MPEP 2138.06

35 USC 103 REJECTIONS

The office action dated May 22, 2005 rejected claims 21 and 30 under 35 USC 103(a) as being unpatentable over the combination of U.S. Publication No. 2002/0089542 to Imamura in combination with U.S. Patent No. 5,600,831 to Levy et al. Imamura has been removed as a reference, and no longer applies to the present application. Accordingly, the rejection based on the proposed Imamura-Levy combination is moot, and all claims are in immediate condition for allowance.

CONCLUSION

If any fees are required by this submission, an appropriate fee submittal sheet is enclosed herewith. If fees are required yet this sheet is inadvertently missing, or the fees are incorrect in amount, please charge the charge the required fees (or credit any overpayment) to Deposit Account No. 07-1445.

Respectfully submitted,

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